

## **REMARKS**

### **Status of the Claims**

Claims 1-11 are pending in this application.

Claims 1-5 are rejected.

Claims 6-11 have been added.

Claims 1 and 4 have been amended. Support for these amendments can be found throughout the specification, claims, and drawings, as originally filed.

### **Rejection of Claims 1 and 3-5 Under 35 U.S.C. § 102(b)**

Claims 1 and 3-5 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by U.S. Patent No. 4,681,409 to Enomoto (hereafter the '409 patent). The Office Action stated:

Enomoto shows a vehicle mirror including a mirror housing (10) with reflective elements and an electrically powered folding mechanism (30) for folding the mirror forward and backward (See fig. 8), wherein forward travel of the mirror housing is greater than backward travel (shown in fig. 8). Enomoto further shows a sail portion (20) and at least one attachment on (14, etc.) between the mirror housing and the sail portion, the folding mechanism folding the mirror at a connection point between the arm and sail portion. Note also that the rearward folded position is adjacent a side window of the vehicle.

Applicant respectfully traverses the 35 U.S.C. § 102(b) rejection of claims 1 and 3-5 as being anticipated by the '409 patent. Applicant submits that claim 1 of the present application has been amended to include a "scalp connected to an exterior surface of said mirror housing, wherein said scalp is non-planar and shaped to provide aerodynamic benefits." See Claim 1 of the present application. Applicant submits that the '409 patent does not disclose a scalp connected to the exterior surface of the housing 10. The specification of the '409 patent states "...to describe the arrangement of the mirror housing 10 in more detail, a base attaching portion 13 which is recessed

inward a bottom wall 11 of the mirror housing 10 is formed at the portion of the bottom wall 11 of the mirror housing 10 which is located on the side of the base 20. A side wall 12 of the mirror housing is arranged to have a curved portion. A mount 14 is projected from the base attaching portion 13 inward the mirror housing 10.” See Col. 3, Lines 52-60. Nowhere does the specification mention attaching a scalp member. Also the various figures of the ‘409 patent show the housing 10 with no scalp member attached. For all of the above reasons the ‘409 patent does not anticipate each and every element of currently amended claim 1, of which allowance is respectfully requested. Claims 3-5 are all independent claims that depend or ultimately depend from independent claim 1 which has now been determined to be in allowable form. Therefore, Applicant respectfully requests removal of the 35 U.S.C. § 102(b) rejection of claims 1 and 3-5.

Applicant has added new claims 6-11 that include independent claims 6 and 9. Applicant points out that the ‘409 patent does not anticipate independent claims 6 and 9. More specifically, independent claim 6 describes the vehicle mirror moving between a rearward position adjacent the side window of a vehicle and a forward position substantially ahead of the vehicle windshield. The ‘409 patent does not disclose this limitation. Independent claim 9 discloses that when the mirror moves in a forward direction the overall width of the vehicle is reduced and is smaller than when the mirror is moved to the farthest position in the rearward direction. The ‘409 patent does not disclose such a limitation. Claims 7, 8, 9, and 11 are dependent upon either independent claim 6 or independent claim 9; therefore, they incorporated all of the limitations of the underlying base claims which as described above is patentable in view of the ‘409 patent.

Additionally the ‘409 patent does not teach or suggest having a scalp attached to the housing. Therefore, the ‘409 patent cannot properly be used to render claims 1 and

3-5 obvious. The '409 patent could also not be used to render obvious new claims 6-11. As discussed above independent claim 6 describes the mirror moving between a rearward position adjacent the side window of a vehicle and a forward position substantially ahead of a vehicle windshield. The '409 patent does not teach or suggest having the mirror move to a forward position substantially ahead of a vehicle windshield; therefore, the '409 patent cannot properly be used to render independent claim 6 or dependent claims 7 and 8 obvious. Additionally newly added claim 9 describes the mirror moving in a forward direction so that the overall width of the vehicle is smaller when the mirror is in the forward position than when the mirror is in the farthest position in the rearward direction. The '409 patent does not teach or suggest that the overall width of the vehicle being less when the mirror is in the forward position than when it is in the farthest position rearward; therefore, independent claim 9 and dependent claims 10 and 11 cannot be rendered obvious by the '409 patent.

Claims 1 and 3-5 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,626,084 to Kumai (hereafter the '084 patent). The Office Action stated:

Kumai shows a vehicle mirror including a mirror housing (5) with reflective element and an electrically powered folding mechanism (10) for folding the mirror forward and backward (Abstract), wherein the forward travel of the mirror housing is greater than the backward travel (See Figs. 4 and 5). Kumai further shows a sail portion (1) and at least one attachment arm (8) between the mirror housing and the sail portion, the folding mechanism folding the mirror at the connection point between the arm and sail portion. Note also that the rearward folded position is adjacent a side window of the vehicle.

Applicant now respectfully traverses the 35 U.S.C. § 102(b) rejection of claims 1 and 3-5 as being anticipated by the '084 patent. Applicant submits that currently amended claim 1 includes a "scalp connected to an exterior surface of said mirror housing, wherein said scalp is non-planar and shaped to provide aerodynamic benefits."

Applicant submits that the '084 patent does not disclose a scalp connected to the exterior surface housing. The '084 patent is directed to an electrically foldable door mirror having various clutching mechanisms for allowing the mirror to pivot if when it receives an external shock. See summary section of the '084 patent. The mirror body is represented and described in the '084 patent figures as label number 5. The specification and the drawings of the '084 patent do not disclose a scalp connected to the mirror body 5. Therefore, Applicant submits that currently amended claim 1 is not anticipated by the '084 patent; therefore, Applicant respectfully requests removal of the rejection of claim 1. Additionally claims 3-5 are either dependent directly upon or ultimately dependent from claim 1; therefore, removal of the rejection with respect to these dependent claims is also requested.

The specification of the '084 patent does not teach or suggest attaching a scalp to the exterior surface of the mirror housing: Nowhere in the drawings or specification is the shape or the exterior surface of the mirror housing described. Therefore, the '084 patent could not be used to render claims 1 and 3-5 obvious. As such, Applicant respectfully requests allowance of claims 1 and 3-5.

Applicant has added new claims 6-11 that include independent claims 6 and 9. Applicant points out that the '084 patent does not anticipate or render obvious independent claims 6 and 9. More specifically, independent claim 6 describes a vehicle mirror moving between a rearward position adjacent the side window of a vehicle and a forward position substantially ahead of the vehicle windshield. The '084 patent does not disclose this limitation. Independent claim 9 discloses that when the mirror moves in a forward direction the overall width of the vehicle is reduced and is smaller than when the mirror is moved to the farthest position in a rearward direction. The '084 patent does not disclose such a limitation. Claims 7, 8, 9 and 11 are dependent upon either

impendent claim 6 or independent claim 9; therefore, they incorporate all of the limitations of the underlining base claims which as described above are patentable in view of the '084 patent.

The '084 patent could also not be used to render obvious new claims 6-11. As discussed above independent claim 6 describes the mirror moving between a rearward position adjacent the side window of a vehicle and a forward position substantially ahead of a vehicle windshield. The '084 patent does not teach or suggest having a mirror moved to a forward position substantially ahead of the vehicle windshield; therefore, the '084 patent cannot properly be used to render independent 6 or dependent claims 7 and 8 obvious. Additionally newly claim 9 describes the mirror moving in a forward direction so that the overall width of the vehicle is smaller when the mirror is in the forward position than when the mirror is in the farthest position in the rearward direction. The '084 patent does not teach or suggest the overall width of the vehicle being less when the mirror is in the forward position than when it is in the farthest position rearward; therefore, independent claim 9 and dependent claims 10 and 11 cannot be rendered obvious by the '084 patent.

### **Rejection of Claims 2 Under 35 U.S.C. § 103**

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over either the '409 patent in view of U.S. Patent No. 5,375,014 to Fujie (hereafter the '014 patent); or the '084 patent in view of the '014 patent. In order for a claim for obviousness to be formulated, there must be some basis in the art for combining or modifying the references to render the claimed invention obvious. Applicant now traverses the rejection of claim 2 because Applicant believes that there is no basis for the proposed combination of references. Claim 2 is dependent upon currently amended

claim 1, therefore all of the limitations of claim 1 plus claim 2 must be rendered obvious by the proposed combination.

As discussed above, claim 1 has been amended to include a scalp connected to an exterior surface of the mirror housing. The combination of the '409 patent in view of '084 patent and further in view of the '014 patent fail to disclose a scalp connected to the exterior surface of the mirror housing. As stated above in the 35 U.S.C. § 102(b) section the specification of the '409 patent and the '084 patent do not teach or suggest having a scalp connected to the exterior surface of the mirror housing; therefore, there is no basis or motivation to combine the '409 patent or the '084 patent with the '014 patent to render currently amended claim 2 obvious. Furthermore, the '014 patent does not have a label number for the mirror housing and the mirror housing as shown in the drawings and does not have a scalp connected to the exterior surface of the mirror housing.

The '409 or the '084 patents alone or in combination with the '014 patent do not render new claims 6-11 obvious. As discussed above in the 35 U.S.C. § 102(b), the '409 and '084 patents fail to teach or suggest a mirror that folds to both a rearward position adjacent a side window and a forward position substantially ahead of a vehicle windshield. The '014 patent does not resolve the shortcomings of the '409 patent or the '084 patent in order to render claim 2 of the present application obvious. As such Applicant respectfully maintains that the proposed combination of references stated in the Office Action are not properly combinable since there is no basis for combining the references to render claim 2 of the present application obvious. Applicant respectfully requests removal of the 35 U.S.C. § 103(a) rejection of claim 2 and allowance thereof.

Independent claim 6 describes the mirror moving between a rearward position adjacent the side window of a vehicle and a forward position substantially ahead of a vehicle windshield. The '014 patent shows rotating the mirror to a position adjacent the front windshield; however, the patent does not teach or suggest rotating the mirror in a rearward position that is adjacent the side window of a vehicle. Fig. 1 of the '014 patent only depicts the mirror rotating in a forward direction to rest adjacent a forward windshield 1a. See Col. 2, Lines 64-68. Also the type of mirror depicted in the '014 patent is not combinable with the teachings of the mirrors depicted in the '409 and '084 patents. The '014 patent shows a base member 2 (see Fig. 1) located in front of the windshield 1a. This means that the mirror pivot point cannot rotate in a rearward direction to be adjacent a side window as claimed in claims 6-8 of the subject application. The specification of the '014 patent does not teach or suggest this limitation. In contrast the '409 and '084 patents show the mirror rotating the rearward direction adjacent the side window of a vehicle; however, they do not teach or suggest moving the mirror in a forward direction substantially in from of the windshield. For this reason the '409 or '084 patents are not properly combinable with the '014 patent to render obvious newly added independent claim 6 and dependent claims 7 and 8.

The proposed combination of references presented the office action do not render claims 9-11 obvious since there is no basis for combining the '409 patent or the '084 patent with the '014 patent to render claims 9-11 obvious. Independent claim 9 describes the mirror moving in a forward direction so that the overall width of the vehicle is smaller when the mirror is in the forward position than when the mirror is in the farthest position in the rearward position. The '409 and '084 patents do not teach or suggest any differences in the width dimensions of the vehicle when the mirrors are in the forward position as opposed to the rearward position. The '014 patent does not

teach or suggest the overall width of the vehicle being less when the mirror is the forward position than when it is in the farthest position rearward. Since there is no basis for combining the references due to lack of motivation, the rejection stated in the office action will not apply to claim 9 or claims 10 and 11 which depend from new claim 9. As such Applicant respectfully requests allowance of newly added claims 6-11.

### **CONCLUSION**

It is respectfully submitted that in view of the above amendments and remarks the claims 1-11 as presented, are patentably distinguishable because the cited patents, whether taken alone or in combination, do not teach, suggest or render obvious, the present invention. Therefore, Applicant submits that the pending claims are properly allowable, which allowance is respectfully requested.

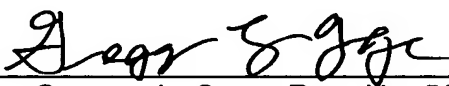
The Examiner is invited to telephone the Applicants undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Respectfully submitted,

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